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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/723,172  
Filing Date: November 26, 2003  
Appellant(s): MCEWAN, JAMES A.

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Jason A. Houdek  
For Appellant

**EXAMINER'S ANSWER**

This is in response to an original appeal brief filed on October 25, 2006 appealing from the Office action mailed on September 21, 2005.

**Supplemental Examiner's Answer**

This Examiner's Answer replaces the Examiner's Answer mailed on December 01, 2006 and the Supplemental Examiner's Answer mailed on April 09, 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct as filed. However, in view of Appellant's arguments in the Appeal Brief filed on October 25, 2006, the rejections of claims 1 and 2 under 35 USC § 112, first and second paragraph are hereby withdrawn; and claims 2-4 and 11-13 are now indicated allowable, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims; and claims 14-20 are allowed.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct.

**a. DOUBLE PATENTING REJECTION:**

Claim 1 is rejected under the judicially created of obviousness-type double patenting.

**b. WITHDRAWN REJECTIONS:**

In view of Appellant's arguments in the Appeal Brief filed on October 25, 2006, the following grounds of rejections are not presented for review on appeal because they have been withdrawn by the examiner.

a. The rejection of claims 1 and 2 under 35 USC § 112, first paragraph is hereby withdrawn.

b. The rejection of claims 1 and 2 under 35 USC § 112, second paragraph

is hereby withdrawn.

c. The rejection under 103(a) of claims 2, 12-14, and 17-20, as being unpatentable over Schlamadinger (Patent number 5,159,815), in view of Yogo (Patent number 4,549,470), is hereby withdrawn.

d. The rejection under 103(a) of claims 3-4, and 15-16, as being unpatentable over Schlamadinger (Patent number 5,159,815), in view of Yogo (Patent number 4,549,470), and further in view of Hauer (Patent Number 4,994,660), is hereby withdrawn.

#### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

#### **(8) Evidence Relied Upon**

5,159,815	SCHLAMADINGER	11-1992
4,549,470	YOGO	10-1985
4,994,660	HAUER	02-1991

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

a. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,658,846 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the patent anticipates application claim 1. Accordingly, application claim 1 is not patentably distinct from patent claim 1.

Patent claim 1 requires following elements:

- an actuator rod for a turbocharger pressure control assembly,
- the actuator comprising:
  1. a first elongate portion defining a first rod end,
  2. a second portion defining a second rod end,
  3. said first and second portions being pivotally joined to one another to allow a degree relative pivotal motion between said two portions in at least one plane perpendicular to the axis of said elongate first portion, and
  4. said second portion of the actuator rod being welded to said lever arm.

whereas, the instant application claim 1 required following elements:

- an actuator rod for a turbocharger pressure control assembly,

- the actuator comprising:
  1. a first elongate portion defining a first rod end,
  2. a second portion defining a second rod end, and
  3. said first and second portions being pivotally joined to one another to allow a degree relative pivotal motion between said two portions in at least one plane containing the axis of said elongate first portion.
  4. a lever arm fixedly connected to said second portion of actuator rod.

Thus it is apparent that the more specific patent claim 1 encompasses application claim 1. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer. Note that since Application claim 1 anticipated by Patent claim 1 and since anticipation is the epitome of obviousness, then Application claim 1 is obvious over Patent claim 1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

b. Claims 1, 5-8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlamadinger (Patent number 5,159,815), in view of Yogo (Patent number 4,549,470).

Schlamadinger discloses an actuator rod (25, I, II) for a turbocharger pressure control assembly, the actuator rod comprising a first portion (25 I, II) defining a first rod end, and a second portion (28) defining a second rod end, said first and second portions (25, I, II; and 28) being pivotally joined to one another to allow a degree of relative pivotal motion between said two portions in at least one plane containing the axis of said first portion (See Figures 2 and 4);

a pneumatic actuator (24) connected to said first rod end (See Figures 2 and 4);  
the pneumatic actuator (24) comprising a spring loaded diaphragm housed within a pressure chamber (24b), the diaphragm (D) being attached to the first rod end ((25 I, II) (See Figures 2 and 4);

a valve assembly (V), end of said actuating rod being connected to said actuator and the other end being connected to the valve assembly, whereby the pneumatic actuator controls of the valve assembly via the actuator rod (25, I, II); the valve assembly (V) further comprising a lever arm (Not Numbered) extending from and connected to a valve (V), said second portion (28) of the actuator rod being a lever arm secured/ fixedly connected/ to said lever arm extending from the valve assembly by the way of which the valve is operated (See Figures 2 and 4).

However, Schlamadinger fails to disclose the first portion being elongated.

Yogo teaches that it is conventional in the linking mechanism art, to utilize the elongate first portion (14) (See Figures 1 and 2).

It would have been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized the elongate first portion, as taught by Yogo, to improve the control of the linear movement of the actuator in the smooth manner.

#### **(10) Response to Argument**

1. With regard to the 35 U.S.C. 103(a) rejection of base Claims 1, 5-8, and 10, are Schlamdinger (Patent number 5,159,815), and Yogo (Patent number 4,549,470) fail to disclose or suggest the second portion of the actuator rod as having been claimed.

The examiner respectfully disagrees with the appellant. Based on the description of the instant invention as disclosed on Page 7, the second and third paragraph, the appellant states that: "Returning now to the spherical rod end joint, this comprises a spherical actuator rod end 17a and a cylindrical rod end piece 17b which provides a socket for the spherical rod end 17a and which is welded to the lever arm. The spherical rod end joint 17a/17b (Read as either 17a or 17b, emphasis added) provides for relative movement between the actuator rod 17 and the lever arm so that the actuator rod 17 maintains its alignment with the lever arm as it reciprocates back and forth. The spherical rod end joint also obviates the need to provide an adjustable length actuator rod 17, and enables a simplified set up procedure, as described below.



Since the spherical rod end joint 17a/17b (Read as either 17a or 17b, emphasis added) provides for the necessary pivotable movement between the actuator rod 17 and the lever arm 19, no separate pivotal joint needs to be made between the lever arm 19 and the end piece 17b of the actuator rod. Rather, the lever arm is simply welded to both the wastegate valve stem and the end of the actuator rod (i.e. the end piece 17b). In contrast to the known weld to set methods described above, the lever arm 19 in accordance with the present invention is pre-assembled together with the wastegate valve rather than as part of the actuator assembly. The lever arm 19 is attached to the valve stem 20 before the actuator is mounted to the turbocharger."

With the description as set forth in the instant invention, the Schlamadinger reference is read on the claimed limitations.

Read as rod 17 in the instant application (1<sup>st</sup> portion of rod)

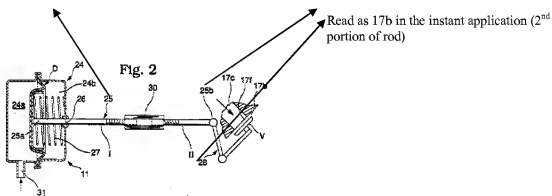
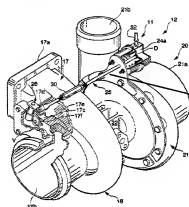
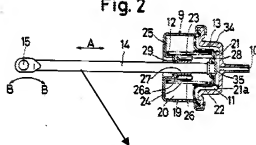


Fig. 4



Figures 2 and 4 of Schlamadinger

Fig. 2



An elongate portion

Figure 2 of Yogo

The end portion (25b) connected to the linkage assembly (28) and pivotably related to the rod (25), is considered as the performance of the end portion 17b (the second portion of the rod) pivotably related to the first portion of the rod 17a as being claimed in the instant application.

Additionally, the examiner just relies on the elongation of the rod (the whole/unique piece elongate first portion of the rod) in the Yogo reference; whereas, the Schlamadinger discloses the first portion of the rod comprising two pieces (I, II) connected by a sleeve 30. The Schlamadinger rod structure does not provide the linear movement control of the actuator in the smooth manner as the Yogo whole/unique piece elongate rod does.

2. Appellant has provided no arguments related to the obviousness-type double patenting rejection. The Board is urged to affirm this rejection.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 3748

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

TTB  
July 28, 2009

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